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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,761	12/05/2003	Charles A. Hamilton	END920030144US1	3210
7590 John R. Pivnichny IBM Corporation / IP Law Dept. IQ0A Bldg. 040-3 1701 North Street Endicott, NY 13760			EXAMINER CHANG, SUNRAY	
			ART UNIT 2121	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS		MAIL DATE 01/10/2007	DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	10/729,761	HAMILTON ET AL.
	Examiner	Art Unit
	Sunray Chang	2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 October 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-11,13-15,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 2,12 and 16 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-11,13-15,17 and 18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in responsive to the paper filed on October 26th, 2006.

Claims 1, 3 – 11, 13 – 15 and 17 – 18 are presented for examination.

Claims 1, 3 – 11, 13 – 15 and 17 – 18 are rejected.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1, 3 – 11, 13 – 15 and 17 – 18 are rejected under 35 U.S.C. 101** because the claimed invention lacks patentable utility. Specifically, claims 1, 11 and 15 drawn to a method for defining a learning solution using a step of aligning a plurality of solution components to said solution context. The Examiner submits that Applicant's have not recited any limitations relating to a practical application in the technological arts. (see MPEP 2106)

An invention which is eligible for patenting under 35 U.S.C. § 101 is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “**useful, concrete and tangible result.**” The test for practical application as applied by the examiner involves the determination of the following factors:

(1) "Useful" – The Supreme Court in Diamond v. Diehr requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

(2) "Tangible" – Applying In re Warmerdam, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. § 101. In Warmerdam the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium which enabled its functionality to be realized.

(3) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

The examiner respectfully submits, under current PTO practice, and in view of the 112(1) rejections, that the claimed invention does not recite either a useful, concrete, or tangible result and is merely drawn to a mathematical algorithm.

The claims are not concrete because Applicants claim for a step for aligning a plurality of solution components to said solution context; yet, fail to indicate how to "align solution components to said solution context".

For example, in specification, page 4, lines 6 – 8, "second program instruction means for aligning a plurality of solution components to the solution context, and wherein both the program instruction means are recorded on the medium"; page 6, lines 16 – 23, "Each of the solution

components 14-22 is configured to align that component with specific learning solution context

12. By way of example, if a zone of context 12 has a high informal learning content, then a business measurement of measurement component 16 developed in the past for formal learning may have to be removed, de-emphasized, or modified. A new measurement geared to informal learning may have to be selected or developed in measurement component 16". It is not clear how to use program instruction means to "align" a plurality of different solutions for different fields: "Purpose/Outcomes", "Measurement", "Technology/Infrastructure", Resources" and "Process".

Claim Rejections - 35 USC § 112.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3 – 11, 13 – 15 and 17 – 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, independent claims include limitations drawn to an aligning mean. But the specification does not disclose the methodology for actually how to align solution components. No algorithms, techniques or flow charts are disclosed. While in specification, for example, makes references to, page 4, lines 6 – 8, "second program instruction means for aligning a

plurality of solution components to the solution context, and wherein both the program instruction means are recorded on the medium“; page 6, lines 16 – 23, “Each of the solution components 14-22 is configured to align that component with specific learning solution context

12. By way of example, if a zone of context 12 has a high informal learning content, then a business measurement of measurement component 16 developed in the past for formal learning may have to be removed, de-emphasized, or modified. A new measurement geared to informal learning may have to be selected or developed in measurement component 16”. Applicant’s specification appears to be drawn entirely to procedures of alignment. Applicants have not disclosed specifically how to use program instruction means to “align” a plurality of different solutions for different fields: “Purpose/Outcomes”, “Measurement”, Technology/Infrastructure”, Resources” and “Process”. Such that one skilled in the art could make and/or use the claimed invention without undue experimentation. Dependent claims inherit this defect.

4. Claims 1, 3 – 11, 13 – 15 and 17 – 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, independent claims include limitations drawn to an aligning mean. But the specification does not disclose the methodology for actually how to align solution components. No algorithms, techniques or flow charts are disclosed. While in specification, for example, makes references to, page 4, lines 6 – 8, “second program instruction means for aligning a

plurality of solution components to the solution context, and wherein both the program instruction means are recorded on the medium“; page 6, lines 16 – 23, “Each of the solution components 14-22 is configured to align that component with specific learning solution context

12. By way of example, if a zone of context 12 has a high informal learning content, then a business measurement of measurement component 16 developed in the past for formal learning may have to be removed, de-emphasized, or modified. A new measurement geared to informal learning may have to be selected or developed in measurement component 16”. Applicant’s specification appears to be drawn entirely to procedures of alignment. Applicants have not disclosed specifically how to use program instruction means to “align” a plurality of different solutions for different fields: “Purpose/Outcomes”, “Measurement”, Technology/Infrastructure”, Resources” and “Process”. Accordingly, a skilled artisan would not know how to make and/or use the claimed invention from the written description contained in the specification. Dependent claims inherit this defect.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 3 – 11, 13 – 15 and 17 – 18 are rejected** under 35 U.S.C. 102(b) as being anticipated by Edward Alun Sketch (U.S. PG. Pub. No. 2002/0077884, and referred to as Sketch hereinafter).

Regarding Claim 1, Sketch discloses:

A process for defining a learning solution, comprising the steps of: providing a learning solution context (see Abstract, lines 3-8. "providing a variety of learning solutions for eliminating gaps between the assessed level of functional competency and a level of functional competency required for the employment function."); and aligning a plurality of solution components to said solution context. (see Figures 1-5. Figures 1-5 show the technology, processes, and methods which are disclosed as the solution components in applicant's specification.)

Regarding Claim 3, Sketch discloses:

The process of claim 1, wherein said zones represent types of interaction. (see pg 3, para 0032-0048. In these paragraphs **Sketch** discloses many different types learning solution or types of training which include various methods of . interaction.)

Regarding Claim 4, Sketch discloses:

The process of claim 1, wherein said solution components comprise purpose/outcomes, measurement, technology/infrastructure, resources, and process. (see Figures 1-5. Figures 1-5 show the technology, processes, and methods which are disclosed as the solution components in applicant's specification.)

Regarding Claim 5, Sketch discloses:

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The process of claim 4, wherein said purpose is a business purpose comprising increasing sales, or decreasing errors (see Figure 3. "Sketch discloses being able to think cross-functionally about ideas that impact the business" Examiner notes that increasing sales or decreasing errors are two of the most important aspects of a business therefore thinking cross-functionally about ideas that impact the business would including thinking about ideas that would increase sales or decrease errors as claimed by applicant.)

Regarding Claim 6, Sketch discloses:

The process of claim 4, wherein said outcomes comprises employee compliance with regulations, certification in a profession, or performing new procedures. (see pg 1, para 0009. "eliminating gaps between the employee's current level of functional competency and the level of functional competency required for the employee's employment function." & see pg 2, para 0012)

Regarding Claim 7, Sketch discloses:

The process of claim 4, wherein said measurement includes calculating a return on investment for learner performance. (see Figure 5, pg 1, para 0010, lines 1-3 and pg 4, para 0052-0053. Examiner notes evaluation method cited by Sketch in paragraphs 0052-0053 measurement which includes calculating a return on investment for learner performance or equivalent method of measurement as disclosed by applicant's specification.)

Regarding Claim 8, Sketch discloses:

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The process of claim 4, wherein said technology/infrastructure includes network, hardware, and software, for access and delivery of learning experiences. (see Figure 4 and pg 4, para 0057-0063)

Regarding Claim 9, Sketch discloses:

The process of claim 4, wherein said resources comprises processes for adapting source material from content and curriculum publishers, scheduling space and equipment, assigning trainers, locating mentors, or licensing software. (see pg 4, para 0056, lines 1-9. "identifying the needs for new learning solutions and linking training resources, products, services, and consulting expertise to the needs of employees and third party learning solution customers. ")

Regarding Claim 10, Sketch discloses:

The process of claim 4, wherein said process comprises new governance committees, incentives to encourage new behaviors, or responsibilities for updates. (see pg 5, para 0064, lines 25-38 and para 0065)

Regarding Claim 11, Sketch discloses:

A system for defining a learning solution, comprising: a computer processor; (see Figure 4) program means on said processor for providing a learning solution context; (see Abstract, lines 3-8. "providing a variety of learning solutions for eliminating gaps between the assessed level of functional competency and a level of functional competency required for the employment function.") and program means on said processor for aligning a plurality of solution components

to said solution context. (see Figures 1-5. Figures 1-5 show the technology, processes, and methods which are disclosed as the solution components in applicant's specification.)

Regarding Claim 13, Sketch discloses:

The system of claim 11, wherein said zones represent types of interaction. (see pg 3, para 0032-0048. In these paragraphs **Sketch** discloses many different types learning solution or types of training which include various methods of interaction.)

Regarding Claim 14, Sketch discloses:

The system of claim 11, wherein said solution components comprise purpose/outcomes, measurement, technology/infrastructure, resources, and process. (see Figures 1-5. Figures 1-5 show the technology, processes, and methods which are disclosed as the solution components in applicant's specification.)

Regarding Claim 15, Sketch discloses:

A computer program product for instructing a processor to define a learning solution, said computer program product comprising:
a computer readable medium; (see Figure 4)
first program instruction means for providing a learning solution context; (see Abstract, lines 3-8. "providing a variety of learning solutions for eliminating gaps between the assessed level of functional competency and a level of functional competency required for the employment function.")

second program instruction means for aligning a plurality of solution components to said solution context; (see Figures 1-5. Figures 1-5 show the technology, processes, and methods which are disclosed as the solution components in applicant's specification) and wherein both said program instruction means are recorded on said medium.

Regarding Claim 17, Sketch discloses:

The computer program product of claim 15, wherein said zones represent types of interaction (see pg 3, para 0032-0048. In these paragraphs **Sketch** discloses many different types learning solution or types of training which include various methods of interaction.).

Regarding Claim 18, Sketch discloses:

The computer program product of claim 15, wherein said solution components comprise purpose/outcomes, measurements, technology/infrastructure, resources, and process (see Figures 1-5. Figures 1-5 show the technology, processes, and methods which are disclosed as the solution components in applicant's specification.).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 1, 11, and 16 are rejected under 35 U.S.C. 103(a)** as being unpatentable over **Sketch** (USPN: 2002/0077884) in view of **Gray** (USPN: 2006/0036629).

Sketch discloses an invention similar to that of the applicant's invention, however fails to disclose a circular diagram having zones and an inner circular area.

Gray teaches a system and process for identifying objects and/or points nearby a given object or point that has a circular diagram having zones and an inner circular area. (see Figure 4)

It would be obvious to one of ordinary skill in the arts at the time of the invention to modify the invention of **Sketch** to include the circular diagram having zones and an inner circular area taught by **Gray** to quickly search for all objects within a certain radius of point (ra, dec) by looking in certain zones, and then only in certain parts of each zone.

7. **Claims 1, 11, and 16 are rejected under 35 U.S.C. 103(a)** as being unpatentable over **Sketch** (USPN: 200210077884) in view of **Gray** (USPN: 2006/0036629) in further view of **Gregory Lloyd** (2001, Gain Credit with CLEP (College Level Examination Program) hereinafter referred to as **Lloyd**.

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Lloyd teaches defining a ratio of informal learning to formal learning. (see paragraphs 2-4. **Lloyd** teaches a CLEP program that allow people to use their prior life experiences and education to take a CLEP exam and receive college credit in addition to taking college level courses to receive a degree from a college/university. The Examiner notes that the CLEP exam would be the informal training as claimed by applicant whereas the actual college level course taken would be the formal training as claimed by applicant In addition, the Examiner notes that the person's GPA would be the defining of informal learning to formal learning as claimed by applicant)

It would be obvious to one of ordinary skill in the arts at the time of the invention formal to informal learning taught by **Lloyd** to define the amount of informal learning and formal learning used in the learning process.

Response to Arguments

8. Since the claimed subject matter, "aligning a plurality of different solutions", has been further rejected by 112 first paragraph for failing to specify how to use program instruction means to "align" a plurality of different solutions for different fields: "Purpose/Outcomes", "Measurement", Technology/Infrastructure", Resources" and "Process", forth 102 & 103 rejections remained still.

9. The forth 101 rejection further includes 112 first paragraph rejections and explanations to be cited again in current office action which remains non-final.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunray Chang who may be reached Monday through Friday, between 8:00 a.m. and 5:00 p.m. EST. via telephone number (571) 272-3682 or facsimile transmission (571) 273-3682 or email sunray.chang@uspto.gov.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on (571) 272-3687.

The official facsimile transmission number for the organization where this application or proceeding is assigned is (571) 273-8300.



Anthony Knight
Supervisory Primary Examiner
Group Art Unit 2121
Technology Center 2100
U.S. Patent and Trademark Office

January 4, 2007